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EXAMINER

MDE, A

ART UNIT

2712

PAPER NUMBER

DATE MAILED:

12/08/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/666,653

Applicant(s)

Honda et al.

Examiner

Aung S. Moe

Group Art Unit

2712



☒ Responsive to communication(s) filed on Aug 17, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-26, 29, and 30 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) 19-26 is/are allowed.

☒ Claim(s) 1-18, 29, and 30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. **Please note that this application has been transferred to a different Examiner.**

Continued Prosecution Application

2. The request filed on 9/17/1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/666,653 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Arguments

3. Applicant's arguments with respect to claims 1-18 and 29-30 have been considered but are moot in view of the new ground(s) of rejection.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in instant Application No. 08/666,653, filed on Sep. 17, 1999.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-7 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (U.S. 5,710,954) in view of Kori et al. (U.S. 5,513,010).

Regarding claim 1, Inoue '954 discloses a camera which includes both silver salt and video recording capabilities. Therefore, the Inoue '954 camera includes a silver salt picture shooting section, a video picture shooting section and a video signal recording means. In col. 9, lines 25+, Inoue '954 states that information relating to the picture can be stored on the film along with the image and the use of a video recording medium (i.e., the recording unit 125 for storing the moving pictures).

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Furthermore, it is noted that Inoue '954 does not explicitly show that the video signal recording means is capable of recording information relating to the picture (i.e., time/date, and ID data) along with the signal on the video recording means, and further stored the still and motion pictures on the video recording medium, and the still pictures being distinguished from the motion pictures based on the video information which is stored in a data area of the video recording medium and reproducing the video signal and video information from the recording medium, wherein still picture are identified by video information stored in the data area of the video recording medium as specified in claim 1.

However, the above mentioned claimed limitations are well-known in the art as evidenced by the teaching of Kori '010. In this case, Kori '010 teaches that in the digital video signal recording and reproducing system (Figs. 2 and 25), it is well-known to record/reproduce such information relating to the picture (i.e., time/date, and ID data) along with the signal on the video recording means (i.e., Figs. 5C-6B, 14A-14E, 17 of Kori '010), and Kori '010 further teaches that the still pictures and motion pictures are stored on the video recording medium (Figs. 30A-30C, 32A-33F; col. 17 & 18, lines 20+), and the still pictures being distinguished from the motion pictures based on the video information which is stored in a data area of the video recording medium and reproducing the video signal and video information from the recording medium (i.e., noted that INDEX ID signals are stored on the recording medium for distinguishing the motion and still pictures; see col. 15, lines 25+ of Kori '010), wherein still picture are identified by video

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information stored in the data area of the video recording medium (col. 19, lines 4+) as specified in claim 1.

In view of the above, having the system of Inoue '954 and then given the well-established teaching of Kori '010, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Inoue '954 as taught by Kori '010, since Kori '010 states at column 1, lines 50+ that such a modification would provide the capability of high speed cuing of both still pictures and moving pictures thereof.

Moreover, the rest of the rejection of claim 1 and the rejection of claims 2-7 are set forth in the previous Office action (please see paper no. 7 & 12).

As for new claim 29, it is noted that the combination of Inoue '954 and Kori '010 shows control logic for searching recording medium based on an index to retrieve a previously captured still picture to be edited and the associated video information (i.e., see the elements 26-27, 29-30 & col. 21, lines 50-68 of Inoue '954 and the elements 85 and Figs. 35-38, col. 6, lines 45+), said previously captured still pictures to be edited and associated video information being associated with a still picture captured on the silver salt based (i.e., noted that Inoue '954 shows that previously captured still picture and associated video information being associated with a still picture captured on the silver salt-based medium; see col. 14, lines 40+, col. 21, lines 50+ and Kori '010 teaches the searching of the previously captured still picture base on the index to retrieve for editing purposes; see Figs. 35-38 of Kori '010);

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control logic for displaying a first screen presenting the previously captured still picture to be edited, coupled with the associated video information; and displaying a second screen for editing the video information associated with the previously captured still picture (see Figs. 7, 19, 20, 23, 28, 30A-30C of Inoue '954 and col. 18, lines 30+ of Kori '010).

Therefore, claim 29 is obvious over Inoue '954 in view of Kori '010 for at least the reasons discussed above.

Since claim 30 correspond to claims 1-7, claim 30 is analyzed as previously discussed with respect to claims 1-7 as previously discussed.

7. Claims 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '954 in view of Wash (U.S. 4,974,096).

As for claim 8, it is considered equivalent to claim 1 with the additional limitations to an identification number being identified with the film and an index recording section for searching the recording medium for separately stored information pertaining to silver salt shooting information, and for collecting together and recording index data thereof.

In this case, Inoue '954 shows in figure 1 and "film information detecting unit" (24) which is capable of detecting information about the film (col. 6, lines 59+). Although Inoue '954 does not explicitly state that such information can include an "ID" number of the film and the frame number, Inoue '954 does use the open phrase "or the like" which leaves the disclosure open to include any kind of information which would have been obvious to one of ordinary skill in the art.

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Moreover, An ID number would have been obvious since it uniquely identifies the film being used so that it can be accessed quickly and appropriately in post-processing (i.e., noted the element 236 of Fig. 25). Furthermore, the frame number would have been equally obvious, since in any post-processing, the processor would need to know which frame number was being processed in order to know how to process it.

In addition, the broadest reasonable interpretation of the index recording section reads on the aggregate of information which is stored on the film along with each photograph (see Fig. 4), thus, the magnetic recording layer along the top of the film can be considered as the "index data recording section."

To further support the Examiner's position, Wash '096 reference is cited to show the obvious teaching of the above mentioned claimed limitations. Moreover, Wash '096 teaches the use of a silver salt film individual identification number/frame number in the image shooting apparatus for outputting an individual identification number and a frame number of the silver salt film used as a recording medium for the silver salt picture shooting section (see Fig. 2; col. 10, line 30-col. 11, line 68);

and index data recording section for searching the recording medium for separately stored information pertaining to silver salt shooting information, and for collecting together and recording index data which forms an aggregate of the separately stored silver salt shooting information as specified in claim 8 (see Figs. 5-7, col. 6, lines 65+; col. 8, lines 15+; col. 9, lines 10+).

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In view of the above, having the system of Inoue '954 and then given the well-established teaching of Wash '096, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Inoue '954 as taught by Wash '096, since Wash '096 states at column 2, lines 55+ that such a modification would enable to quickly read a particular desired piece of information for a particular frame without undue searching through or reading other data to find the one desired pieces.

As for dependent claims 9-18, these claims were treated in the previous Office action (please see paper no. 7 & 12).

8. Claims 19-26 are allowed for the reasons set forth in the previous Office action (please see paper no. 7 & 12).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Kozuki '943 and Kobayashi '514 show a video signal recording and reproducing apparatus for recording and reproducing a still and motion pictures on the recording medium thereof.

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b. Sasaki '017 shows a still camera having a picture shooting section and a recording section for recording a picture signals and the information relating to the picture (i.e., time/date) thereof.

c. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Aung S. Moe** whose telephone number is (703) 306-3021. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on (703) 305-4929.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communication intended for entry)


or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

A. Moe 

December 1, 1999


Wendy Garber
Supervisory Patent Examiner
Technology Center 2700